

**REMARKS**

Upon entry of the present amendment, claims 1–12 and 21–35 will be pending in the application. Claims 1–12 have been amended. Claims 13–20 have been cancelled. Claims 21–35 are new. Support in the specification for the new claims is indicated in the chart below. No new matter has been added. The right to prosecute any cancelled subject matter in one or more continuation, continuation-in-part, or divisional applications is hereby reserved.

Claim 21	page 4, line 24 – page 5, line 2
Claim 22	page 8, lines 22–27
Claim 23	page 8, line 27 – page 9, line 5
Claim 24	page 8, line 27 – page 9, line 12
Claim 25	page 9, lines 9–12
Claim 26	page 13, lines 2–13
Claim 27	page 15, lines 9–11
Claim 28	page 8, line 22 – page 13, line 1
Claim 29	page 8, line 22 – page 13, line 1
Claim 30	page 2, lines 1–6
Claim 31	page 14, lines 7–9
Claim 32	page 14, line 17 – page 15, line 11
Claim 33	page 13, lines 10–17; page 15, lines 12–21
Claim 34	page 16, line 18 – page 18, line 1
Claim 35	page 14, line 17 – page 15, line 11

**Rejections under 35 U.S.C. § 112**

Claims 6 and 12 have been rejected under 35 U.S.C. § 112, second paragraph, as being allegedly indefinite. Claims 6 and 12 have been amended to remove the objected term “and/or”. Support for the amendments is found, for example, in the paragraph beginning at page 10, line 5 of the specification. Accordingly, it is believed that this objection has been overcome.

### Rejections under 35 U.S.C. § 103

Claims 1–12 have been rejected under 35 U.S.C. § 103(a) as being allegedly obvious in view of the article titled “AIG Tackles Claims Management,” *National Underwriter* Vol. 103, No. 15, page 32 (April 12, 1999) (“AIG”) in combination with Larkin *et al.*, U.S. Patent Publication 2002/0069089 (June 6, 2002) (“Larkin”). Applicants respectfully traverse these rejections.

Claim 1 has been amended for clarity and focus on the invention. Support for this amendment is found throughout the specification as filed, for example, in the summary paragraph at page 19, line 10 – page 20, line 2 and in the Figure 1 flowchart.

Neither AIG nor Larkin disclose a method for providing medical referrals and medical assignments to medical insurance claims as recited by Applicants’ amended claim 1, nor do AIG and Larkin together suggest such a method. AIG describes an “Integrated Disability Management” claims management program, which is “designed to help reduce costs by applying workers’ comp claims management strategies to non-occupational claims” (AIG, paragraph 3; emphasis added)<sup>2</sup>. AIG does not, as the Examiner alleges, disclose a method for “*automatically performing assignment logic* on the reported claim and the collected data to determine whether the assignment is warranted” (Office action, paragraph 7; italics added). Rather, AIG describes a method for “a telephonic case management system that profiles incoming claims and enables case managers to identify those most in need of case management” (AIG, paragraph 4). In summary, AIG describes a program that features “telephonic and face-to-face case management” (AIG, paragraph 8) and is silent as to any medical referral or assignment logic, whereas the Applicants describe a method comprising **automated medical referral logic**.

Larkin describes a case management system comprising “determining an injury diagnosis and a treatment plan” (Larkin, paragraph 0043). Larkin does not, as the Examiner alleges, disclose a “case management method for workplace injuries in which *medical assignment* is performed on a reported claim *to determine what type of medical assignment is warranted* (see paragraphs 0044-0046, 0048, and 0052)” (Office action, paragraph 8; italics and boldface added). Larkin does not describe a method for medical assignment at all, but rather for “injury diagnosis” (Larkin, paragraph 0043). The “injury is usually diagnosed prior to other useful case

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<sup>2</sup> Paragraphs numbered according to printed article; copy enclosed.

management operations” (Larkin, paragraph 0043) and may use information provided by one of “two paths” (Larkin, paragraph 0044): (i) a “questionnaire” (Larkin, paragraph 0045) compared with a “diagnosis database” (Larkin, paragraph 0046), wherein the database “typically contain[s] information developed by medical research teams” (Larkin, paragraph 0038); or (ii) a “medical professional” (Larkin, paragraph 0047). Thereafter, (a) “an injury classification code corresponding to the diagnosis” can be extracted from an “injury classification database” (Larkin, paragraph 0048), which “contains standard ICD-9 [International Classification of Diseases, 9th] codes” (Larkin, paragraph 0038), and (b) the method “automates scheduling of assessment testing” (Larkin, paragraph 0052). In summary, Larkin describes a method for calculating an ICD-9 injury classification code and using it to schedule diagnostics, not a method for determining **when medical referral is warranted**, as described by the Applicants, and is silent as to any use of that code other than for calculating or determining a treatment plan.

The telephonic case management system as described in AIG is not at all relevant to the presently claimed method for **automated medical referral logic**, as described by the Applicants. Consideration of an input ICD-9 code is but one factor in the medical referral logic described by the Applicants. Significantly, that logic is **automated**, whereas the system disclosed by AIG, cited by the Examiner, uses human logic in a telephonic interaction. A method and system of automated medical referral logic, as described by the Applicants, would not be obvious to one having ordinary skill in the art in view of AIG and Larkin.

As amended claim 1 is not taught by AIG and Larkin, it is believed that the Examiner’s rejection of claims 2–12 is rendered moot. The Examiner’s specific concerns regarding Larkin are addressed below.

Larkin does not disclose “analyzing previous claims that are similar to the reported medical insurance claim and their medical referrals and assignments” as recited in claims 3 and 4. In paragraph 0046, Larkin describes providing a set of possible diagnoses in response to knowledge about a work environment. Such a set of diagnoses might result in a more precise ICD-9 code. However, in combination with AIG, no positive contribution to medical referral, human or automated, is disclosed or suggested. Furthermore, Applicants take the position that use of knowledge about a work environment is not related to use of knowledge about previous similar claims and their medical referrals and assignments.

Regarding claim 5, Larkin does not refer to selecting a “sub-list” of nature of injury (NOI) and associated part of body (POB) combinations “that desire medical referral” (claim 5). In paragraph 0042, Larkin describes a user entering information on a single claim. In paragraph 0046, Larkin describes comparing questionnaire responses to a “diagnosis database”. The diagnosis database is described in paragraph 0038 as, similar to a “treatment database”, containing “information developed by medical research teams, e.g. in the form of summaries or distillations of actual medical case studies”. Such a treatment/diagnosis databases are not related to lists of NOI and POB, and certainly not to sub-lists of NOI and POB associated with medical referral. Moreover, Larkin describes a “treatment plan” (Larkin, paragraph 0049), including “scheduling of assessment testing”, and “pre-certification” of scheduled tests” (Larkin, paragraph 0052). Scheduling and pre-certifying diagnostic tests as a part of a treatment plan, as described by Larkin, are not part of “automatically performing medical referral logic”, as described and claimed by the Applicants.

Regarding claim 6, in paragraph 0048, Larkin describes selecting a treatment pathway from one of the following: “non-invasive”, “removal”, or “repair”. No mention is made in Larkin of the relation of these pathways to surgery, or of using any of these selections in automated medical referral logic, as indicators of whether or not medical referral is warranted, as described by the Applicants.

Regarding claim 7, Larkin paragraph 007 describes a “first report of injury”, not a new date of disability, as described by the Applicants.

Regarding claim 8, Applicants describe a sum of monetary values incurred by temporary total (TT) disability, temporary partial (TP) disability, and medical. Larkin describes a “degree of disability management (DoDM) code...identified based on the injury classification code and the associated job code” (Larkin, paragraph 007). The DoDM metric, is described in Larkin as a “tool to measure MCO [managed care organization] effectiveness in managing treatment and returning workers to employment” (Larkin, paragraph 0005); it is not a decisioning point in automated medical referral logic, as described by the Applicants. It is further not a decisioning point based on monetary value, as acknowledged by the Examiner.

Regarding claims 9 and 10, Larkin does not describe a “preparing a list of ICD-9 codes *for which medical referral is warranted*”, as described by the Applicants (claim 9; italics added).

Larkin describes assignment of ICD-9 codes based on assessment of symptoms (Larkin, paragraphs 0007, 0008, 0019). Larkin does not, however, describe identifying a list of ICD-9 codes for which medical referral is warranted.

Regarding claim 11, Larkin describes calculating an “estimated return-to-work date” (Larkin, paragraph 0018). Larkin does not describe “assessing the reported claim and the collected data to determine whether the injured individual has not returned to work for more than a predetermined period of time after the injury” and using that assessment as part of an automated medical referral logic to determine if medical referral is warranted, as described by the Applicants (claim 11).

For at least the reasons given above in connection with claims 6–9, it is believed that claim 12 is distinguished over the prior art.

### CONCLUSION

Applicants respectfully submit that, as described above, the cited prior art does not show or suggest the combination of features recited in the claims. Applicants do not concede that the cited prior art shows any of the elements recited in the claims. However, Applicants have provided specific examples of elements in the claims that are clearly not present in the cited prior art.

Applicants strongly emphasize that one reviewing the prosecution history should not interpret any of the examples Applicants have described herein in connection with distinguishing over the prior art as limiting to those specific features in isolation. Rather, Applicants assert that it is the combination of elements recited in each of the claims, when each claim is interpreted as a whole, which is patentable. Applicants have emphasized certain features in the claims as clearly not present in the cited references, as discussed above. However, Applicants do not concede that other features in the claims are found in the prior art. Rather, for the sake of simplicity, Applicants are providing examples of why the claims described above are distinguishable over the cited prior art.

Applicants wish to clarify for the record, if necessary, that the claims have been amended to expedite prosecution and/or to explicitly recite that which is already present within the claims. Moreover, Applicants reserve the right to pursue the original and/or complimentary subject matter recited in the present claims in a continuation application.

Any narrowing amendments made to the claims in the present Amendment are not to be construed as a surrender of any subject matter between the original claims and the present claims; rather merely as Applicants' best attempt at providing one or more definitions of what the Applicants believe to be suitable patent protection. In addition, the present claims provide the intended scope of protection that Applicants are seeking for this application. Therefore, no estoppel should be presumed, and Applicants' claims are intended to include a scope of protection under the Doctrine of Equivalents and/or statutory equivalents, i.e., all equivalents that are substantially the same as the presently claimed invention.

Further, Applicants hereby retract any arguments and/or statements made during prosecution that were rejected by the Examiner during prosecution and/or that were unnecessary to obtain allowance, and only maintain the arguments that persuaded the Examiner with respect

to the allowability of the patent claims, as one of ordinary skill would understand from a review of the prosecution history. That is, Applicants specifically retract statements that one of ordinary skill would recognize from reading the file history were not necessary, not used, and/or were rejected by the Examiner in allowing the patent application.

For all the reasons advanced above, Applicants respectfully submit that the rejections have been overcome and should be withdrawn.

For all the reasons advanced above, Applicants respectfully submit that the Application is in condition for allowance, and that such action is earnestly solicited.